

ESTTA Tracking number: **ESTTA512812**

Filing date: **12/21/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Clorox Company
Granted to Date of previous extension	12/26/2012
Address	1221 Broadway Oakland, CA 94612 UNITED STATES
Correspondence information	Adam C. Brink The Clorox Company 1221 Broadway Oakland, CA 94612 UNITED STATES trademarks@clorox.com Phone:5102717000

Applicant Information

Application No	85523698	Publication date	08/28/2012
Opposition Filing Date	12/21/2012	Opposition Period Ends	12/26/2012
International Registration No.	NONE	International Registration Date	NONE
Applicant	FABRICA DE JABON LA CORONA S.A. DE C.V. Carlos B. Zetina #80 Parque Industrial Xalostoc Ecatepec de Morelos, MEXICO		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Laundry bleach


Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1771020	Application Date	10/19/1992
Registration Date	05/18/1993	Foreign Priority Date	NONE
Word Mark	PINE-SOL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1956/06/28 First Use In Commerce: 1956/06/28 general household cleaner

U.S. Registration No.	2798766	Application Date	04/08/2002
Registration Date	12/23/2003	Foreign Priority Date	NONE
Word Mark	PINE-SOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2003/06/20 First Use In Commerce: 2003/06/20 FLOOR CLEANER		

U.S. Registration No.	2472451	Application Date	03/20/2000
Registration Date	07/24/2001	Foreign Priority Date	NONE
Word Mark	POWER OF PINE-SOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2000/10/02 First Use In Commerce: 2000/10/02 HOUSEHOLD CLEANING COMPOSITIONS		

U.S. Registration No.	2472460	Application Date	04/10/2000
Registration Date	07/24/2001	Foreign Priority Date	NONE
Word Mark	THE POWER OF PINE-SOL THE SMELL OF CLEAN		

Design Mark	THE POWER OF PINE-SOL THE SMELL OF CLEAN
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2000/10/02 First Use In Commerce: 2000/10/02 HOUSEHOLD CLEANING COMPOSITIONS

Attachments	76393309#TMSN.gif (1 page)(bytes) 76004149#TMSN.gif (1 page)(bytes) 76022270#TMSN.gif (1 page)(bytes) 2012.12.21 Notice of Opposition.pdf (23 pages)(2914675 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Adam C. Brink/
Name	Adam C. Brink
Date	12/21/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

THE CLOROX COMPANY,

Opposer,

v.

FABRICA DE JABON LA CORONA S.A.
DE C.V.

Applicant.

Notice of Opposition

Mark:

PURO SOL (Ser. No. 85523698)

Opposition No.: _____

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

The Clorox Company (“Opposer” or “Clorox”), a Delaware corporation with its principal place of business at 1221 Broadway, Oakland, California 94612, believes that it will be damaged by the registration of the mark PURO SOL (Ser. No. 85523698), and hereby opposes same.

As grounds for opposition, Opposer alleges:

1. Fabrica de Jabon la Corona S.A. de C.V. (“Applicant”), a corporation of Mexico with an address at Carlos B. Zetina #80 Parque Industrial Xalostoc Ecatepec de Morelos, Mexico, filed Application Serial No. 85523698 (the “Opposed Application”) for the mark PURO SOL (the “Proposed Mark”) in connection with “Liquid bleach” (“Applicant’s Goods”) in Class 3.

2. The Opposed Application was filed with the United States Patent and Trademark Office (“PTO”) on January 24, 2012 (“Applicant’s Filing Date”) based on Applicant’s foreign registration of the Proposed Mark.

3. Opposer is a Delaware corporation headquartered at 1221 Broadway, Oakland, California 94612. Opposer's product line includes laundry bleach, household bleach, as well as household, floor, and all-purpose cleaners. Opposer's goods are widely distributed throughout the United States.

4. Opposer is the owner of U.S. Registration No. 1771020 (issued on May 18, 1993) for the mark PINE-SOL for "General household cleaner" in Class 3. Opposer filed the underlying Application Serial No. 74323164 on October 19, 1992, and the mark was first used at least as early as June 28, 1956, which predates Applicant's Filing Date. A copy of the Registration Certificate, TESS record, and Assign Status record for U.S. Registration No. 1771020, showing the current status and title of the registration, is attached as Exhibit 1.

5. Opposer is the owner of U.S. Registration No. 2798766 (issued on December 23, 2003) for the mark PINE-SOL for "Floor cleaner" in Class 3. Opposer filed the underlying Application Serial No. 76393309 on April 8, 2002, and the mark was first used at least as early as June 20, 2003, which predates Applicant's Filing Date. A copy of the Registration Certificate, TESS record, and Assign Status record for U.S. Registration No. 2798766, showing the current status and title of the registration, is attached as Exhibit 2.

6. Opposer is the owner of U.S. Registration No. 2472451 (issued on July 24, 2001) for the mark POWER OF PINE-SOL for use in connection with "Household cleaning composition" in Class 3. Opposer filed the underlying Application Serial No. 76004149 on March 20, 2000, and the mark was first used at least as early as October 2, 2000, which predates Applicant's Filing Date. A copy of the Registration Certificate, TESS record, and Assign Status record for U.S. Registration No. 2472451, showing the current status and title of the registration, is attached as Exhibit 3.

7. Opposer is the owner of U.S. Registration No. 2472460 (issued on July 24, 2001) for the mark THE POWER OF PINE-SOL THE SMELL OF CLEAN for "Household cleaning compositions" in Class 3. Opposer filed the underlying Application Serial No. 76022270 on April 10, 2000, and the mark was first used at least as early as October 2, 2000, which predates Applicant's Filing Date. A copy of the Registration Certificate, TESS record, and Assign Status record for U.S. Registration No. 2472460,

showing the current status and title of the registration, is attached as Exhibit 4. The marks shown in Opposer's Registration Nos. 1771020, 2798766, 2472451, and 2472460 are collectively referred to herein as the "PINE-SOL Marks."

8. Opposer has promoted and sold products under the PINE-SOL Marks in commerce in the United States since at least as early as June 28, 1956. Opposer has exercised care and diligence in developing the exceptional and reliable products it provides in connection with the PINE-SOL Marks. Opposer has allocated substantial resources to developing the PINE-SOL Marks and marketing the products sold in connection with the PINE-SOL Marks. Opposer has invested in television advertisements, print advertisements, press releases, and an extensive web-based marketing program to promote the PINE-SOL Marks. As a result of these efforts and over 50 continuous years of use, Opposer has developed substantial consumer recognition and valuable goodwill in the PINE-SOL Marks.

9. As a result of the substantial and long-standing use of the PINE-SOL Marks, the PINE-SOL Marks are extremely strong, and have achieved such widespread consumer recognition that the PINE-SOL Marks are famous. Due to the high quality of Opposer's products, the PINE-SOL Marks are seen as representative of quality, reliability and consistency, and have become extremely valuable assets carrying substantial goodwill.

10. The Proposed Mark is confusingly similar in appearance, sound, connotation and commercial impression to Opposer's PINE-SOL Marks.

11. Applicant's Goods are identical to or closely related to the goods sold by Opposer in connection with the PINE-SOL Marks.

12. On information and belief, Applicant sought to capitalize on the extensive goodwill and fame of the PINE-SOL Marks by adopting the Proposed Mark, in spite of Opposer's rights in the PINE-SOL Marks and Opposer's long-standing and continuous use of the PINE-SOL Marks.

13. On information and belief, Applicant filed the Opposed Application with knowledge of Opposer's prior use of, and trademark rights in, the PINE-SOL Marks, and with the intention of unfairly trading upon the goodwill associated with Opposer's PINE-SOL Marks.

14. Applicant's registration of the Proposed Mark would create a likelihood of confusion, mistake or deception in the minds of prospective consumers as to the origin, sponsorship, or approval of Applicant's Goods, within the meaning of Section 43 of the Lanham Act, 15 U.S.C. §1125(a).

15. Registration of the Opposed Application and/or Applicant's use of the Proposed Mark would irreparably damage Opposer's exclusive right to use, promote, and license the PINE-SOL Marks in connection with goods and services. Such damage to Opposer will be continuing, as the public is likely to believe that Opposer is sponsoring or endorsing Applicant's Goods.

16. Registration of the Opposed Application and/or Applicant's use of the Proposed Mark would seriously injure the reputation that Opposer has established for the wide variety of goods and services produced or licensed by Opposer under or in association with the PINE-SOL Marks. Deficiencies or faults in the quality of the Applicant's Goods are likely to reflect negatively upon Opposer, and result in loss of revenue to Opposer and damage to its reputation.

FIRST GROUND FOR RELIEF

LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. §1052(d)

17. Opposer incorporates by reference paragraphs 1 through 16, as if fully set forth herein.

18. Opposer has used the PINE-SOL Marks in commerce in the United States since long before Applicant's Filing Date.

19. The filing dates and the dates of first use in commerce associated with Opposer's Registration Nos. 1771020, 2798766, 2472451, and 2472460 for the PINE-SOL Marks all precede Applicant's Filing Date.

20. The Proposed Mark is confusingly similar to Opposer's PINE-SOL Marks in sight, sound, connotation and commercial impression.

21. Opposer offers goods in connection with the PINE-SOL Marks that are identical to Applicant's Goods, and Opposer offers other highly related goods.

22. Applicant's registration and/or use of the Proposed Mark is likely to create the erroneous impression that Applicant's Goods originate with, are sponsored or promoted by, or are otherwise associated with, Opposer.

23. Applicant's registration and/or use of the Proposed Mark is likely to cause confusion, mistake, or deception in the minds of prospective consumers as to the origin, sponsorship, or approval of Applicant's Goods within the meaning of Section 2 of the Lanham Act, 15 U.S.C. §1052(d).

SECOND GROUND FOR RELIEF

DILUTION UNDER 15 U.S.C. §1125(c)

24. Opposer incorporates by reference paragraphs 1 through 16, as if fully set forth herein.

25. The PINE-SOL Marks are widely recognized by the consuming public of the United States as a designation of the source of the goods of Opposer, and have been so recognized since long before Applicant's Filing Date.

26. The PINE-SOL Marks are famous, and have been famous since long before Applicant's Filing Date.

27. Applicant's registration and/or use of the Proposed Mark is likely to dilute by blurring the strength and value of the PINE-SOL Marks, by affecting the ability of these marks to serve as unique identifiers of Opposer's goods, thereby causing serious injury to the reputation and goodwill that Opposer has established in its PINE-SOL Marks, within the meaning of Section 43 of the Lanham Act, 15 U.S.C. §1125(c)(2)(B).

28. Applicant's registration and/or use of the Proposed Mark is likely to dilute by tarnishment the strength and value of the PINE-SOL Marks by creating an association that harms the reputation of Opposer's famous PINE-SOL Marks, within the meaning of Section 43 of the Lanham Act, 15 U.S.C. §1125(c)(2)(C).

WHEREFORE, Opposer believes that it would be damaged by registration of the Proposed Mark, and respectfully requests that registration of Application Ser. No. 85523698 be refused, and that this Opposition be sustained in favor of Opposer.

The PTO is authorized by Adam C. Brink, Attorney for Opposer, to charge the requisite filing fee of \$300.00 to the Deposit Account of The Clorox Company, Account No. 03-2270. Please deduct any additional fees that may be due, or credit any overpayment, to the same Deposit Account.

DATED: December 21, 2012

ADAM C. BRINK
THE CLOROX COMPANY
1221 Broadway
Oakland, California 94612
Telephone: 510-208-1496
Facsimile: 510-271-1652



Adam C. Brink

Attorney for Opposer
THE CLOROX COMPANY

PROOF OF SERVICE BY MAIL

The undersigned declares and says as follows: my business address is 1221 Broadway, Oakland, CA 94612. I am employed in the City of Oakland and County of Alameda; I am over the age of 18 years, and I am not a party to this cause. I am readily familiar with this business' practices for collection and processing of correspondence for mailing with the United States Postal Services. On the same day that a sealed envelope is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service with postage fully prepaid.

I served the within **Notice of Opposition** to Applicant through its counsel of record:

Arturo Perez-Guerrero, Esq.
Law Offices of Arturo Pérez-Guerrero
P.O. Box 9024163
San Juan, Puerto Rico 00902-4163

by placing a true copy thereof, enclosed in a sealed envelope with postage thereon fully prepaid, for deposit in the United States mail for collection and mailing on this day following ordinary business practices of The Clorox Company.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this Declaration is executed in Oakland, California, this 21st day of December, 2012.

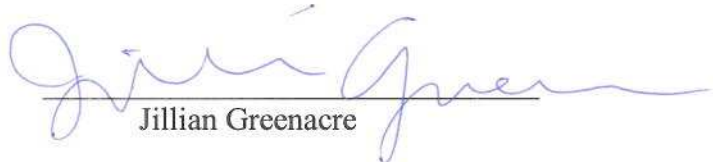

Jillian Greenacre

Exhibit 1

Int. Cl.: 3

Prior U.S. Cl.: 52

United States Patent and Trademark Office

Reg. No. 1,771,020

Registered May 18, 1993

**TRADEMARK
PRINCIPAL REGISTER**

PINE-SOL

**CLOROX COMPANY, THE (DELAWARE COR-
PORATION)
1221 BROADWAY
OAKLAND, CA 94612**

**FOR: GENERAL HOUSEHOLD CLEANER,
IN CLASS 3 (U.S. CL. 52).**

**FIRST USE 6-28-1956; IN COMMERCE
6-28-1956.**

OWNER OF U.S. REG. NO. 672,626.

SER. NO. 74-323,164, FILED 10-19-1992.

JEFFREY SMITH, EXAMINING ATTORNEY



United States Patent and Trademark Office

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Word Mark PINE-SOL

Goods and Services IC 003. US 052. G & S: general household cleaner. FIRST USE: 19560628. FIRST USE IN COMMERCE: 19560628

Mark Drawing Code (1) TYPED DRAWING

Serial Number 74323164

Filing Date October 19, 1992

Current Basis 1A

Original Filing Basis 1A

Published for Opposition February 23, 1993

Registration Number 1771020

Registration Date May 18, 1993

Owner (REGISTRANT) Clorox Company, The CORPORATION DELAWARE 1221 Broadway Oakland CALIFORNIA 94612

Prior Registrations 0672626

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20030326.

Renewal 1ST RENEWAL 20030326

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For Serial Number: 74323164

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Exhibit 2

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

Reg. No. 2,798,766

United States Patent and Trademark Office

Registered Dec. 23, 2003

**TRADEMARK
PRINCIPAL REGISTER**

PINE-SOL

CLOROX COMPANY, THE (DELAWARE COR-
PORATION)
1221 BROADWAY
OAKLAND, CA 94612

OWNER OF U.S. REG. NOS. 672,626, 2,472,460,
AND OTHERS.

FOR: FLOOR CLEANER, IN CLASS 3 (U.S. CLS. 1,
4, 6, 50, 51 AND 52).

SN 76-393,309, FILED 4-8-2002.

FIRST USE 6-20-2003; IN COMMERCE 6-20-2003.

LESLIE RICHARDS, EXAMINING ATTORNEY



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Typed Drawing

Word Mark	PINE-SOL
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: FLOOR CLEANER. FIRST USE: 20030620. FIRST USE IN COMMERCE: 20030620
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76393309
Filing Date	April 8, 2002
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	November 26, 2002
Registration Number	2798766
Registration Date	December 23, 2003
Owner	(REGISTRANT) CLOROX COMPANY, THE CORPORATION DELAWARE 1221 Broadway Oakland CALIFORNIA 94612
Attorney of Record	TIM J HUMPHREY
Prior Registrations	0672626;1771020;2472451;2472460;AND OTHERS
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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For Serial Number: 76393309

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Exhibit 3

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

Reg. No. 2,472,451

United States Patent and Trademark Office

Registered July 24, 2001

**TRADEMARK
PRINCIPAL REGISTER**

POWER OF PINE-SOL

**CLOROX COMPANY, THE (DELAWARE COR-
PORATION)
1221 BROADWAY
OAKLAND, CA 94612**

OWNER OF U.S. REG. NOS. 672,626 AND 1,771,020.

**FOR: HOUSEHOLD CLEANING COMPOSITIONS,
IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).**

SN 76-004,149, FILED 3-20-2000.

FIRST USE 10-2-2000; IN COMMERCE 10-2-2000.

JUDITH GRUNDY, EXAMINING ATTORNEY



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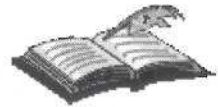
Typed Drawing

Word Mark	POWER OF PINE-SOL
Goods and Services	IC 003. US 001 004 006 050 051 052. G & S: HOUSEHOLD CLEANING COMPOSITIONS. FIRST USE: 20001002. FIRST USE IN COMMERCE: 20001002
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76004149
Filing Date	March 20, 2000
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	November 28, 2000
Registration Number	2472451
Registration Date	July 24, 2001
Owner	(REGISTRANT) Clorox Company, The CORPORATION DELAWARE 1221 Broadway Oakland CALIFORNIA 94612
Attorney of Record	STEPHEN M. WESTBROOK
Prior Registrations	0672626; 1771020
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20100925.
Renewal	1ST RENEWAL 20100925
Live/Dead Indicator	LIVE



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For Serial Number: 76004149

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Exhibit 4

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

United States Patent and Trademark Office

Reg. No. 2,472,460

Registered July 24, 2001

**TRADEMARK
PRINCIPAL REGISTER**

THE POWER OF PINE-SOL THE SMELL OF CLEAN

**CLOROX COMPANY, THE (DELAWARE CORPORATION)
1221 BROADWAY
OAKLAND, CA 94612**

OWNER OF U.S. REG. NOS. 672,626 AND 1,771,020.

**FOR: HOUSEHOLD CLEANING COMPOSITIONS,
IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).**

SN 76-022,270, FILED 4-10-2000.

FIRST USE 10-2-2000; IN COMMERCE 10-2-2000.

JUDITH GRUNDY, EXAMINING ATTORNEY



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Word Mark	THE POWER OF PINE-SOL THE SMELL OF CLEAN
Goods and Services	IC 003, US 001 004 006 050 051 052. G & S: HOUSEHOLD CLEANING COMPOSITIONS. FIRST USE: 20001002. FIRST USE IN COMMERCE: 20001002
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76022270
Filing Date	April 10, 2000
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	November 28, 2000
Registration Number	2472460
Registration Date	July 24, 2001
Owner	(REGISTRANT) Clorox Company, The CORPORATION DELAWARE 1221 Broadway Oakland CALIFORNIA 94612
Prior Registrations	0672626;1771020
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20100925.
Renewal	1ST RENEWAL 20100925
Live/Dead Indicator	LIVE

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